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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,760	07/05/2005	Hideyuki Kobayashi	036910-0114	7036

22428 7590 12/27/2005

FOLEY AND LARDNER LLP  
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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/534,760	KOBAYASHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Naghmeh Mehrpour	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/13/05</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### Information Disclosure Statement

2. The information disclosure statement filed reference listed in the information Disclosure Submitted on 05/13/05 have been considered by the examiner (see attached PTO-1449

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 6, 8-22, are rejected under 35 U.S.C. 102(e) as being anticipated by Thornton (US patent 6,751,454).

Regarding claim 1, Thornton teaches a charging method for use in a service providing system having a first terminal device owned by a user and (b) a service providing server, connected to the first terminal device via a communication network, offering an

information providing service to the first terminal device (see figure 2), the method comprising:

(1) a step of a service providing server transmitting, to the first terminal device, a modification command for modifying a predetermined parameter determining an operation of the first terminal device (col 7 lines 9-28)

(11) a step of the first terminal device modifying the predetermined parameter only when the first terminal device receives the modification command for modifying the predetermined parameter from the service providing server (col 7 lines 9-28); and

(111) a step of the service providing server charging the user owning the first terminal device a fee for the transmission of the modification command for modifying the predetermined parameter, in a case where the service providing server transmits, to the first terminal device, the modification command for modifying the predetermined parameter (col 9 lines 1-21).

Regarding claim 2, Thornton teaches a method as set forth in claim 1, wherein: upon receipt of a request for modifying the predetermined parameter from the user, the service providing server transmits, to the first terminal device owned by the user, the modification command for modifying the predetermined parameter in accordance with a content of the received request (col 6 lines 10-22, col 7 lines 9-28, col 9 lines 1-21).

Regarding claim 3, Thornton inherently teaches a method as set forth in claim 2, wherein:

a second terminal device which is different from the first terminal device is owned by the user, the second terminal device being connected to the service providing server via a communication network (see figure 2); and the request for modifying the predetermined parameter to the service providing server is made by the user by means of the second terminal device (col 6 lines 10-22, col 7 lines 9-28 col 9 lines 1-21). When the user is able to use the first device, he will be able to use the second device as well.

Regarding claim 8, Thornton teaches a service providing server for carrying out the charging method for use in a service providing system, as set forth in claim 1 (col 7 lines 9-28).

Regarding claim 9, Thornton inherently teaches a service providing program for causing a computer to execute a process in the service providing server as set forth in claim 8 (col 7 lines 9-28)

Regarding claim 10, Thornton inherently teaches a storage medium storing a service providing program for causing a computer to execute a process in the service providing server as set forth in claim 8 (col 7 lines 9-28)

Regarding claim 11, Thornton inherently teaches a terminal device for carrying out the charging method for use in a service providing system, as set forth in claim 1 (col 7 lines 9-28).

Regarding claim 12, Thornton teaches a terminal processing program for causing a computer to execute a process in the terminal device as set forth in claim 11.

Regarding claim 13, Thornton teaches a recording medium containing a terminal processing program for causing a computer to execute a process in the terminal device as set forth in claim 11 .

Regarding claim 14, Thornton teaches a control method of a service providing server being connected to a first terminal device and a second terminal device via a communication network, the service providing server offering an information providing service with respect to the first terminal device (col 6 lines 10-22) (col 9 lines 1-21)

When the user is able to use the first device, he will be able to use the second device as well, the method comprising:

(1) a modification request accepting step of receiving a modification request from the second terminal device, the modification request requesting to transmit, to the first terminal device, a modification command for modifying a predetermined parameter determining an operation of the first terminal device (col 7 lines 9-28); and  
a modification command transmitting step of generating the modification command in accordance with the modification request, and then transmitting the modification command to the first terminal device (col 7 lines 1-21).

Regarding claim 15, Thornton inherently teaches a method as set forth in claim 14, further comprising:

a validity judging step of judging whether or not the modification request received from the second terminal device is valid (col 8 lines 5-20, col 9 lines 8-21).

Regarding claim 16, Thornton inherently teaches a method as set forth in claim 15, wherein: the first terminal device has a plurality of the parameter, the parameter being settable on a parameter-by-parameter basis, and  
in the step (11I), it is judged whether the modification request received from the second terminal device is valid with reference to a combination-table specifying, in advance, whether or not each combination of the parameters of the first terminal device is permitted (col 9 lines 8-21). The confirmation message, confirm the validity of the request.

Regarding claim 17, Thornton inherently teaches a method as set forth in claim 14, further comprising:

(IV) history recording step of storing, in a history information database, a content of a parameter setting when transmitting the modification command to the first terminal device (col 10 lines 27-40). Most system usually have a backup for recording the history of any action in the system.

Regarding claim 18, Thornton teaches a method as set forth in claim 17, further comprising the step of :

(V) a setting restoration step of generating a modification command for change back a parameter into a previous state in accordance with the history information database, and then transmitting the generated modification command to the first terminal device (col 5 lines 10-63, col 6 lines 22-32) the server instruct the WCD to change from voice mode to data mode and change back to voice mode.

Regarding claim 19, Thornton inherently teaches a service providing server executing the control method of a service providing server, as set forth in claim 14 (col 9 lines 1-21).

Regarding claim 20, Thornton inherently teaches a service providing program for causing a computer to execute the control method of a service providing server, as set forth in claim 14 (col 9 lines 1-20).



Regarding claim 21, Thornton teaches a storage medium containing a service providing program for causing a computer to execute the control method of a service providing server, as set forth in claim 14 (col 9 lines 1-21, lines 60-65, col 10 lines 27-40).

Regarding claim 22, Thornton inherently teaches a service providing system, comprising:

the service providing server as set forth in claim 14, and  
through terminal device and a second terminal device, each of which being connected to the service providing server via a communication network (see figure 2). When the user is able to use the first device, he will be able to use the second device as well.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-6, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton (US patent 6,851,454) in view of Marshall (US Publication 2003/0233278).

Regarding claim 4, Thornton fails to teach a method wherein in offering a service of providing information to the first terminal device, the service providing server charges

the user owning the first terminal device a fee for the service offered. However, Marshall teaches a method wherein in offering a service of providing information to the first terminal device, the service providing server charges the user owning the first terminal device a fee for the service offered (0037). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 5, Thornton fails to teach a method comprising:

(1V) a step of the service providing server, when the first terminal device owned by the user transmits certain information to the service providing server, rewarding the user with one or more points, the points varying in number depending on information received; and

(V) a step of the service providing server using at least one of the points owned by the user for settlement of the charge to the user. However, Marshall teaches a method comprising:

(1V) a step of the service providing server, when the first terminal device owned by the user transmits certain information to the service providing server, rewarding the user with one or more points, the points varying in number depending on information received (0097); and

(V) a step of the service providing server using at least one of the points owned by the user for settlement of the charge to the user (0097). Therefore, it would have been

obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

Regarding claim 6, Thornton fails to teach a method as set forth in the first terminal device is an in-vehicle terminal device provided in an automobile owned by the user, and the predetermined parameter is a parameter determining an operation of the in-vehicle terminal device in a vehicle-antitheft system. However, Marshall teaches a method as set forth in the first terminal device is an in-vehicle terminal device provided in an automobile owned by the user, and the predetermined parameter is a parameter determining an operation of the in-vehicle terminal device in a vehicle-antitheft system (0116). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Marshall with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

7. Claim 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton (US patent 6,851,454) in view of Breed (US Publication 2005/0046584).

Regarding claim 7, Thorton fails to teach a method as set forth in claim 6, wherein: reporting action to be carried out when a sensor provided in the automobile detects an abnormal situation. However, Breed teaches a method as set forth in claim 6, wherein:

reporting action to be carried out when a sensor provided in the automobile detects an abnormal situation (1275). Therefore, it would have been obvious to ordinary skill in the art at the time the invention was made to combine the above teaching of Breed with Thornton, in order to provide a system for altering behavior in a variety of applications such as the status of the events.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Treyz** (US Patent 6,711,474) disclose automobile personal computer systems

**Kariya** (US Patent 6,169,897) disclose mobile system with capabilities to access local information resources

**Takagaki** (US Patent 6,871,048) disclose a mobile communication apparatus and information providing system using the mobile communication apparatus

9. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 571-272-7913. The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (571) 272-7905.


The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

December 21, 2005

  
MELLOY HENRY FOR  
PATENT EXAMINER